



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,054	03/28/2001	Adam R. Schran	10397-1U1	3079

570 7590 06/24/2003

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103-7013

EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
----------	--------------

2171

3

DATE MAILED: 06/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PR3

Office Action Summary	Application No.	Applicant(s)	
	09/820,054	SCHHRAN ET AL.	
	Examiner	Art Unit	
	Etienne P LeRoux	2171	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 2-6, 12-21 and 27-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites “receiving at a server a request from a subscriber to send a list of cookie file sources to the client machine.” One of ordinary skill in the art does not know how to make and use instant invention because the specification does not enable one of ordinary skill in the art to obtain a list of cookie files from a server.

Claims 2-6 are rejected for being dependent from a rejected base claim.

Claims 12-21 and 27-30 are rejected for reasons similar to the above.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites “modifying the master list in accordance with the first and second exception lists, wherein the composite list is the modified master list.” There is insufficient antecedent basis for “the composite list.”

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3-5 and 16-20 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No. 5,826,242 issued to Montulli (hereafter Montulli ‘242).

Regarding claims 1 and 16, Montulli ‘242 discloses:

- a) receiving at a server, a request from a subscriber to send a list of cookie file sources to the client machine [col 2, lines 28-37]
- b) downloading the list from the server to the client machine [col 9, lines 18-36]
- c) using the downloaded list to detect cookie files received at the client machine from sources on the downloaded list [col 9, lines 53-63]

Regarding claims 3 and 18, Montulli ‘242 discloses receiving updates of the downloaded list from the server on a periodic basis [col 9, lines 37-52]

Regarding claims 4 and 19, Montulli '242 discloses displaying the message at the client machine [col 7, lines 40- 43].

Regarding claims 5 and 20, Montulli '242 discloses removing detected cookie files [col 9, lines 33-36]

6. Claims 7 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Pub No US 2002/0078177 issued to Dutta (hereafter Dutta '177).

Regarding claims 7 and 22, Dutta '177 discloses a first exception list of cookie files permitted to be stored [Fig 3], a second exception list of cookie files not permitted to be stored [paragraph 0034], a service provider master list of cookie file sources [paragraph 006 and paragraph 0010], modifying the master list in accordance with the first and second exception list [paragraph 0034]

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

Art Unit: 2171

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 2, 6, 15, 21 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montulli '242 as applied to claims 1, 12 and 16 above, and further in view of US Pat No 6,085,224 issued to Wagner (hereafter Wagner '224).

Regarding claims 2, 15, 21 and 30, Montulli '242 discloses the essential elements of the claimed invention as set forth above, except for a list of cookie files not permitted to be stored. Wagner '224 discloses a list of cookie files not permitted to be stored [col 9, lines 45-55]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Montulli '242 to include a list of cookie files not permitted to be stored as taught by Wagner '224 for the purpose of deleting cookies received from unauthorized clients provided by a server [col 9, line 46].

Regarding claim 6, Montulli '242 discloses the essential elements of the claimed invention except for preventing detected cookie files from being stored in the client machine. Wagner '224 discloses preventing detected cookie files from being stored in the client machine [col 9, lines 30-39]

10. Claims 8 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta '177.

Regarding claims 8 and 23, Dutta '177 discloses the essential elements of the claimed invention as set forth above, except for the composite list is stored in the client machine. It

Art Unit: 2171

would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Dutta '177 to include the composite list is stored in the client machine for the purposes of providing a file which shows all the changes which have been made.

11. Claims 9-11 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta '177 as applied to claim 7 above, and further in view of Montulli '242.

Regarding claims 9 and 24, Dutta '177 discloses the essential elements of the claimed invention as set forth above, except for receiving updates of the downloaded list from the server on a periodic basis. Montulli '242 discloses receiving updates of the downloaded list from the server on a periodic basis [col 9, lines 37-52]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Dutta '177 to include receiving updates of the downloaded list from the server on a periodic basis as taught by Montulli '242 for the purpose of obtaining the latest information from the server.

Regarding claims 10 and 25, Dutta '177 discloses the essential elements of the claimed invention except for removing stored cookie files. Montulli '242 discloses removing stored cookie files [col 9, lines 33-36]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Dutta '177 to include removing stored cookie files as taught by Montulli '242 for the purpose of saving storage space.

Regarding claims 11 and 26, Dutta '177 discloses the essential elements of the claimed invention except for preventing cookie files being stored in the client machine. Montulli '242 discloses preventing cookie files from being stored in the client machine [col 9, lines 33-36]. It would have been obvious to one of ordinary skill I the art at the time the invention was made to

modify Dutta '177 to include preventing cookie files from being stored in the client machine as taught by Montulli '242 for the purpose of saving space on the client's storage system [col 9, line 35].

12. Claims 12-14 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No. 6,092,194 issued to Touboul (hereafter Touboul '194).

Regarding claims 12 and 27, Touboul '194 discloses receiving a cookie master list from the server [col 2, line 17]

Regarding claim 12, Touboul '194 discloses the essential elements of the claimed invention except for deleting cookie file sources according to trusted cookie file source, adding cookie file sources according to untrusted cookie file sources. It would have been obvious to one of ordinary skill in the art to modify Touboul '194 to include deleting cookie file sources according to trusted cookie file source, adding cookie file sources according to untrusted cookie file sources. The ordinarily skilled artisan would have been motivated to include deleting cookie file sources according to trusted cookie file source, adding cookie file sources according to untrusted cookie file sources for the purpose of providing tests to determine whether to allow or block a downloadable [col 2, line 20].

Regarding claims 13 and 28, examiner maintains that storing the master list and the composite list are inherent in Touboul '194.

Regarding claims 14 and 29, Touboul '194 discloses removing cookie files stored in the client machine [col 2, line 20]

13. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Montulli '242 as applied to claim 16 above, and further in view of Dutta '177.

Regarding claim 17, Montulli '242 discloses the essential elements of the claimed invention except for a first exception list of cookie files permitted to be stored, a second exception list of cookie files not permitted to be stored, a service provider master list of cookie file sources, modifying the master list in accordance with the first and second exception list. Dutta '177 discloses a first exception list of cookie files permitted to be stored [Fig 3], a second exception list of cookie files not permitted to be stored [paragraph 0034], a service provider master list of cookie file sources [paragraph 006 and paragraph 0010], modifying the master list in accordance with the first and second exception list [paragraph 0034]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Montulli '242 to include a first exception list of cookie files permitted to be stored, a second exception list of cookie files not permitted to be stored, a service provider master list of cookie file sources, modifying the master list in accordance with the first and second exception list as taught by Dutta '177 for the purpose of including user preferences.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620.

The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Etienne LeRoux

June 20, 2003



SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100